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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,782	08/04/2003	Helynne Smith	SMITH-H	6913
7590	01/10/2006		EXAMINER	MENDIRATTA, VISHU K
Arthur M. Peslak, Esq. MANDEL & PESLAK, LLC Suite 5 80 Scenic Drive Freehold, NJ 07728			ART UNIT	PAPER NUMBER
			3711	
			DATE MAILED: 01/10/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/633,782	SMITH, HEYNNE
	<b>Examiner</b>	<b>Art Unit</b>
	Vishu K. Mendiratta	3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 October 2005.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Amendment***

1. The amendment filed 10/20/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- (a) **New Claim limitation** "U turn capability". There is no indication of a U turn capability/method in the original specification.
- (b) **New Drawing figures 3-6,8,9A-10DD.** There is no indication of any mention of details such as "concrete, plumbing, electrical, being parts of material in the original disclosure. There is also no mention of new detailed structure of cards in the original disclosure. There is also no reference of a newly introduced writing implement (112 as shown in Fig.8) in original disclosure. A mere mention of the game being associated with terminology such as contract/construction bidding does not automatically mean plumbing/concrete/electrical/writing implement.
- (c) **Amended specification** includes terminology not present in original disclosure, for example: "concrete, plumbing, electrical

**Applicant is required to cancel the new matter in the reply to this Office Action.**

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

of the following is required: **Claim limitation “strategically dividing a dice roll” is inconsistent with the disclosure page 4, line 4 which restricts splitting a dice roll.**

***Claim Rejections - 35 USC § 112***

3. Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
4. Claim 1 provides for the use of "U turn structure", "playing cards", "bid boards", but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

5. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"fulfilling contracts" (?) has no clear meaning of what is tangibly happening in the game.

***Claim Rejections - 35 USC § 103***

6. Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Hall (4386778) in view of Whitney (5456473) and Stevens (4411432).

Hall teaches a game board (Fig.1) providing a set of dice (21), playing cards Fig.6-7), game money (2:50), parts representing materials (3:3:7-9), bid boards (Fig.5) with dollar amounts and further engaging in bidding process (3:20-63).

Hall teaches all limitations except that it does not provide miniature trucks for vehicles.

Whitney teaches miniature trucks (40,50) for use in a construction method game.

The art area of board games is a highly competitive amusement area. One way to make the game attractive is to provide miniature simulated articles similar to real situations for making the game look real. In order to make a construction bidding game it would have been obvious to provide miniature vehicles such as provided by Whitney. One of ordinary skill in art at the time the invention was made would have suggested providing miniature simulated trucks to simulate transporting simulated materials during construction management game to make the game real.

Hall teaches all limitations except that it does not each splitting a dice roll to move more than one piece. Stevens teaches splitting dice roll and moving more than one piece to a combined total (4:54-58). Examiner notes that there is no criticality of this method step with respect to a bidding game. Examiner also notes that such method steps are commonly known in the game board art area and used for enhancing the amusement value of the game.

One of ordinary skill in art at the time the invention was made would have suggested including such commonly known steps for making the game attractive.

***Response to Arguments***

7. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K. Mendiratta whose telephone number is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vishu K Mendiratta  
Primary Examiner  
Art Unit 3711

VKM  
December 30, 2005

